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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/446,915 05/22/95 GOEDEL

18N2/0723

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D. P0897P2	
EXAMINER	
ULM, J	
ART UNIT	PAPER NUMBER

1812  
DATE MAILED:

07/23/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

*For Restriction purposes only.*  
☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.                  |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1 to 50 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1 to 50 are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Claims 1 to 50 are pending in the instant application.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1 to 10 and 45 to 50, drawn to a protein which is associated with a tumor necrosis factor receptor and identified in the instant specification as TRAF, classified in Class 530, subclass 350.

II. Claims 11 to 13 and 17, drawn to a nucleic acid encoding a TRAF protein, a vector and cell containing that nucleic acid and a method of producing TRAF protein, classified in Class 435, subclass 69.1.

III. Claim 14, drawn to a molecule of undefined composition and structure, classified in Class undeterminable, subclass undeterminable.

IV. Claims 15 and 16, drawn to an antibody which binds to a TRAF protein, classified in Class 530, subclass 388.22.

V. Claim 18, drawn to a method of obtaining the expression of a TRAF protein by a cell, classified in Class 435, subclass 172.3. It is noted that the claimed method does not require the cell to contain a recombinant DNA encoding TRAF protein.

VI. Claim 19, drawn to a method of detection which employs nucleic acid hybridization, classified in Class 435, subclass 6.

VII. Claims 20, 21, 24, 26 and 27, drawn to a nucleic acid encoding a fusion protein containing the intracellular domain of

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a tumor necrosis factor receptor and a method of using, classified in Class 536, subclass 23.4.

VIII. Claims 22, 23 and 25, drawn to a nucleic acid encoding a fusion protein containing a TRAF protein, classified in Class 536, subclass 23.4.

IX. Claims 28 and 29, drawn to a method of using a nucleic acid probe or primer to detect or amplify a nucleic acid comprising a specific sequence, classified in Class 435, subclass 6.

X. Claim 30, drawn to a method of treatment employing either a protein or a compound of undefined constitution, classified in Class 514, subclass 2.

XI. Claims 31 and 33 to 43, drawn to a method of identifying a substance which interacts with a receptor protein by using a recombinant cell producing a complete receptor, classified in Class 435, subclass 7.1.

XII. Claims 32 and 44, drawn to a method of identifying a substance which interacts with a cytoplasmic domain of a receptor protein by using a recombinant cell producing a chimeric protein, classified in Class 435, subclass 6. Claim 44 is included with this invention because the yeast two-hybrid system requires the construction of fusion gene encoding chimeric proteins and claims 31 and 33 to 43 do not include chimeric proteins.

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The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, VII and VIII are chemically different compounds each of which, if found patentable, would support a separate patent. Distinctness is shown because each of these compounds can be made and used without the other and because they lack a common utility which is based upon a common structural feature.

Invention V is not directly related to any of inventions I to IV and VI to XII.

Invention II is prospectively related to inventions VI, IX and XI as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acid that is invention II can be employed to produce the protein encoded thereby which is a process that is materially different from the processes that are invention VI, IX and XI.

Inventions I and III are related to invention X as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process

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for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the process as claimed can be practiced with the two materially different products which are inventions I and III.

Inventions VII and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acid that is invention VII can be used to make the product encoded thereby which is a process that is materially different from the process that is invention XII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm at telephone number (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM. The fax phone number for this group is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM  
PRIMARY EXAMINER  
GROUP 1800